

PTO/SR/17 (1-06)

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

<b>FEE TRANSMITTAL</b> <b>for FY 2006</b> Patent fees are subject to annual revision. Effective December 8, 2004	<b>Complete if Known</b>	
	Application Number	09/965,113
	Confirmation Number	3953
	Filing Date	September 26, 2001
	First Named Inventor	Lin, et al.
	Examiner Name	L.T. Tran
	Art Unit	1761
<b>TOTAL AMOUNT OF PAYMENT (\$)</b> 620.00		Docket No. 8258X

<b>METHOD OF PAYMENT</b>		<b>FEE CALCULATION (continued)</b>																															
1. <input checked="" type="checkbox"/> The Director is hereby authorized to charge indicated fees submitted on this form, credit any over payments, and charge any additional fee(s) during the pendency of this application to: Deposit Account Number: 16-2480 Deposit Account Name: The Procter & Gamble Company		5. <b>ADDITIONAL FEES</b> <table border="1"> <thead> <tr> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>Extension for reply within 1<sup>st</sup> month</td> <td>(\$120) <input checked="" type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 2<sup>nd</sup> month</td> <td>(\$450) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 3<sup>rd</sup> month</td> <td>(\$1,020) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 4<sup>th</sup> month</td> <td>(\$1,590) <input type="checkbox"/></td> </tr> <tr> <td>Extension for reply within 5<sup>th</sup> month</td> <td>(\$2,160) <input type="checkbox"/></td> </tr> <tr> <td>Information Disclosure Statement fee</td> <td>(\$180) <input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.16(f) Late Oath/Declaration (nonprovisional)</td> <td>(\$130) <input type="checkbox"/></td> </tr> <tr> <td>37 CFR 1.17 (q) Surcharge - Late provisional filing fee or cover sheet</td> <td>(\$50) <input type="checkbox"/></td> </tr> <tr> <td>Non-English specification</td> <td>(\$130) <input type="checkbox"/></td> </tr> <tr> <td>Notice of Appeal</td> <td>(\$500) <input type="checkbox"/></td> </tr> <tr> <td>Filing a brief in support of an appeal</td> <td>(\$500) <input checked="" type="checkbox"/></td> </tr> <tr> <td>Request for oral hearing</td> <td>(\$1,000) <input type="checkbox"/></td> </tr> <tr> <td>Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)</td> <td>(\$1,370) <input type="checkbox"/></td> </tr> <tr> <td>Other:</td> <td><input type="checkbox"/></td> </tr> </tbody> </table>		Fee Description	Fee Paid	Extension for reply within 1 <sup>st</sup> month	(\$120) <input checked="" type="checkbox"/>	Extension for reply within 2 <sup>nd</sup> month	(\$450) <input type="checkbox"/>	Extension for reply within 3 <sup>rd</sup> month	(\$1,020) <input type="checkbox"/>	Extension for reply within 4 <sup>th</sup> month	(\$1,590) <input type="checkbox"/>	Extension for reply within 5 <sup>th</sup> month	(\$2,160) <input type="checkbox"/>	Information Disclosure Statement fee	(\$180) <input type="checkbox"/>	37 CFR 1.16(f) Late Oath/Declaration (nonprovisional)	(\$130) <input type="checkbox"/>	37 CFR 1.17 (q) Surcharge - Late provisional filing fee or cover sheet	(\$50) <input type="checkbox"/>	Non-English specification	(\$130) <input type="checkbox"/>	Notice of Appeal	(\$500) <input type="checkbox"/>	Filing a brief in support of an appeal	(\$500) <input checked="" type="checkbox"/>	Request for oral hearing	(\$1,000) <input type="checkbox"/>	Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)	(\$1,370) <input type="checkbox"/>	Other:	<input type="checkbox"/>
Fee Description	Fee Paid																																
Extension for reply within 1 <sup>st</sup> month	(\$120) <input checked="" type="checkbox"/>																																
Extension for reply within 2 <sup>nd</sup> month	(\$450) <input type="checkbox"/>																																
Extension for reply within 3 <sup>rd</sup> month	(\$1,020) <input type="checkbox"/>																																
Extension for reply within 4 <sup>th</sup> month	(\$1,590) <input type="checkbox"/>																																
Extension for reply within 5 <sup>th</sup> month	(\$2,160) <input type="checkbox"/>																																
Information Disclosure Statement fee	(\$180) <input type="checkbox"/>																																
37 CFR 1.16(f) Late Oath/Declaration (nonprovisional)	(\$130) <input type="checkbox"/>																																
37 CFR 1.17 (q) Surcharge - Late provisional filing fee or cover sheet	(\$50) <input type="checkbox"/>																																
Non-English specification	(\$130) <input type="checkbox"/>																																
Notice of Appeal	(\$500) <input type="checkbox"/>																																
Filing a brief in support of an appeal	(\$500) <input checked="" type="checkbox"/>																																
Request for oral hearing	(\$1,000) <input type="checkbox"/>																																
Acceptance of unintentionally delayed claim for priority under 35 U.S.C. 119, 120, 121, or 365 (a) or (c)	(\$1,370) <input type="checkbox"/>																																
Other:	<input type="checkbox"/>																																
<b>FEE CALCULATION</b> 2. <b>BASIC FILING FEE - Large Entity</b> <table border="1"> <thead> <tr> <th>FILING FEE</th> <th>SEARCH FEE</th> <th>EXAMINATION FEE</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>Application Type</td> <td></td> <td></td> <td></td> </tr> <tr> <td>Nonprovisional (\$300)</td> <td>(\$500)</td> <td>(\$200)</td> <td>(Total = \$1000) <input type="checkbox"/></td> </tr> <tr> <td>Utility</td> <td></td> <td></td> <td></td> </tr> <tr> <td>Design (\$200)</td> <td>(\$100)</td> <td>(\$130)</td> <td>(Total = \$430) <input type="checkbox"/></td> </tr> <tr> <td>Reissue (\$300)</td> <td>(\$500)</td> <td>(\$600)</td> <td>(Total = \$1400) <input type="checkbox"/></td> </tr> <tr> <td>Provisional Utility filing fee</td> <td></td> <td>(Total = \$200) <input type="checkbox"/></td> <td></td> </tr> </tbody> </table>		FILING FEE	SEARCH FEE	EXAMINATION FEE	Fee Paid	Application Type				Nonprovisional (\$300)	(\$500)	(\$200)	(Total = \$1000) <input type="checkbox"/>	Utility				Design (\$200)	(\$100)	(\$130)	(Total = \$430) <input type="checkbox"/>	Reissue (\$300)	(\$500)	(\$600)	(Total = \$1400) <input type="checkbox"/>	Provisional Utility filing fee		(Total = \$200) <input type="checkbox"/>					
FILING FEE	SEARCH FEE	EXAMINATION FEE	Fee Paid																														
Application Type																																	
Nonprovisional (\$300)	(\$500)	(\$200)	(Total = \$1000) <input type="checkbox"/>																														
Utility																																	
Design (\$200)	(\$100)	(\$130)	(Total = \$430) <input type="checkbox"/>																														
Reissue (\$300)	(\$500)	(\$600)	(Total = \$1400) <input type="checkbox"/>																														
Provisional Utility filing fee		(Total = \$200) <input type="checkbox"/>																															
3. <b>APPLICATION SIZE FEE:</b> Sheets of Spec and Drawings <input type="checkbox"/> (\$250 for each 50 sheets in excess of 100, except for sequence and program listings) <b>SUBTOTAL (2)+(3) (\$)</b> 0																																	
4. <b>EXTRA CLAIM FEES FOR UTILITY AND REISSUE:</b> <table border="1"> <thead> <tr> <th>Extra Claims</th> <th>Fee from Below</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr> <td>Total Claims <input type="checkbox"/> - 20** = <input type="checkbox"/> x</td> <td><input type="checkbox"/> =</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Independent Claims <input type="checkbox"/> - 3** = <input type="checkbox"/> x</td> <td><input type="checkbox"/> =</td> <td><input type="checkbox"/></td> </tr> <tr> <td>Multiple Dependent claims:</td> <td><input type="checkbox"/> =</td> <td><input type="checkbox"/></td> </tr> </tbody> </table> ** or number previously paid, if greater; For Reissues, see below <b>Fee Description</b> Claims in excess of 20 (\$50 per claim) Independent claims in excess of 3 (\$200 per claim) Multiple dependent claim, if not paid (\$360) **Reissue: each independent claim over 3 and more than in the original patent (\$200 per claim) **Reissue claims: each claim over 20 and more than original patent (\$50 per claim) <b>SUBTOTAL (4) (\$)</b> 0		Extra Claims	Fee from Below	Fee Paid	Total Claims <input type="checkbox"/> - 20** = <input type="checkbox"/> x	<input type="checkbox"/> =	<input type="checkbox"/>	Independent Claims <input type="checkbox"/> - 3** = <input type="checkbox"/> x	<input type="checkbox"/> =	<input type="checkbox"/>	Multiple Dependent claims:	<input type="checkbox"/> =	<input type="checkbox"/>																				
Extra Claims	Fee from Below	Fee Paid																															
Total Claims <input type="checkbox"/> - 20** = <input type="checkbox"/> x	<input type="checkbox"/> =	<input type="checkbox"/>																															
Independent Claims <input type="checkbox"/> - 3** = <input type="checkbox"/> x	<input type="checkbox"/> =	<input type="checkbox"/>																															
Multiple Dependent claims:	<input type="checkbox"/> =	<input type="checkbox"/>																															
<b>SUBTOTAL (4) (\$)</b> 0		<b>SUBTOTAL (5) (\$)</b> 620																															

<b>SUBMITTED BY</b>		<b>Complete (if applicable)</b>	
Name (Print/Type)	S. Robert Chuey	Registration No. (Attorney/Agent)	39,140
Signature		Telephone	(513) 634-0102
		Date	05/08/2006

+ This collection of information is required by 37 CFR 1.17. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon individual case. Any comments on the amount of time you are required to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P. O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.  
 Fee Transmittal.doc (Revised for P&G use 04/25/2006)

**IMPORTANT CONFIDENTIALITY NOTICE**

The documents accompanying this telecopy transmission contain confidential information belonging to the sender which is legally protected. The information is intended only for the use of the individual or entity named below. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution or the taking of any action in reliance on the contents of this telecopied information is strictly prohibited. If you have received this telecopy in error, please immediately notify us by telephone (collect) to arrange for return of the telecopied document to us.

**TO: Lien Thuy Tran, Group Art Unit 1761 - United States Patent and Trademark Office**

Fax No. 571-273-8300

Phone No. 571-272-1408

**FROM: S. Beth Slovacek (Typed or printed name of person signing Certificate)**

Fax No. 513-634-3752

Phone No. 513-634-4223

**RECEIVED  
CENTRAL FAX CENTER  
MAY - 8 2006**

Application No.: 09/965,113

Inventor(s): Peter Yau Tak Lin, et al.

Filed: September 26, 2001

Docket No.: 8258X

Confirmation No.: 3953

**FACSIMILE TRANSMITTAL SHEET AND****CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. §1.8**

*I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on May 8, 2006, to the above-identified facsimile number.*

S. Beth Slovacek (Signature)

Listed below are the item(s) being submitted with this Certificate of Transmission:\*\*

- 1) Fee Transmittal Form ( 1 page )
- 2) Appellants' Brief on Appeal ( 11 pages )
- 3)
- 4)

Number of Pages Including this Page: 13

**Comments:**

**\*\*Note:** Each paper must have its own certificate of transmission, OR this certificate must identify each submitted paper.

(FAX-USPTO.doc Revised 11/18/2005)

RECEIVED  
CENTRAL FAX CENTER

MAY - 8 2006

P&G Case 8258X

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of :  
Lin *et al.* : Confirmation No.: 3953  
Serial No.: 09/965,113 : Group Art Unit: 1761  
Filed: September 26, 2001 : Examiner: L. T. Tran  
For: IMPROVED EMULSIFIER SYSTEMS FOR USE IN MAKING  
DEHYDRATED STARCH INGREDIENTS

APPELLANTS' BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Appeal is taken from the Final Office Action dated October 7, 2005, finally rejecting Claims 1-5, 7-12, and 38-41 of the present application. Appellants appealed to the Board of Appeals on January 6, 2006. The two month anniversary of this Appeal fell on a Saturday, and as such, a one month extension is believed required and a request is filed herewith.

REAL PARTY IN INTEREST

The real party in interest is The Procter & Gamble Company, assignee of Appellant's, entire right, title, and interest in the invention at issue. The Assignment to the Procter & Gamble Company for this case is recorded at the Patent and Trademark Office at Reel 012575 and Frame 0242.

RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's undersigned legal representative and the Assignee are not aware of any pending appeals or interferences that would be directly affected by or have a bearing on the Board's decision in the subject Appeal.

STATUS OF CLAIMS

Claims 1-5, 7-12, and 38-41 are the subject of this appeal. No other claims are pending or allowed. Claims 6 and 13-37 were cancelled during prosecution. Claims 1-5, 7-12, and 38-41

05/09/2006 AWONDAF1 00000097 162480 09965113

01 FC:1402 500.00 DA  
02 FC:1251 120.00 DA

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

2

were finally rejected in the Final Office Action dated October 7, 2005. The claims on appeal are set forth in the Appendix.

#### STATUS OF AMENDMENTS

No amendments were filed or proposed after the Final Office Action in this case. And it is believed that all previous amendments have been entered and considered.

#### SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention relates to an emulsifier system comprising from 70 to 100%, by weight, of a polyglycerol ester having a polyglycerol backbone of from 2 to about 10 glycerol units. Not more than about 40% of the hydroxyl groups of the polyglycerol are esterified with fatty acids (hereafter "PGE"). The fatty acids are selected from the group consisting of oleic acid, palmitic acid, stearic acid, intermediate melting fatty acids, and mixtures thereof. [Claim 1] Preferably, at least about 80% of the PGEs, by weight, have a polyglycerol backbone of from 2 to about 5 glycerol units. [Claim 2]

By utilizing the improved emulsifier system of the present invention, manufacturers and producers of raw material ingredients for starch-based farinaceous snacks can increase production rate, decrease production costs, or both. [Specification, at page 2, lines 3-5] Additionally, utilization of the improved emulsifier system of the present invention can minimize changes in product aging (i.e., staling). Further, the emulsifier system may reduce the oil content of the fried or baked fabricated farinaceous snack. [Specification, at page 2, lines 10-12]

The improved emulsifying system of the present invention further provides increased flexibility in the process of formulating snacks using rice, wheat, corn and potato (e.g., granules, flakes or other dehydrated potato forms) ingredients. This leads to potential cost reduction, flavor improvement or both. [Specification, at page 2, lines 13-15]

Also important in the fabricated farinaceous foods industry is the cost and speed of the manufacturing process. The improved emulsifier system of the present invention provides process control optimization that allows the maximization of line speed control to be formulated and manufactured (e.g. tailored microstructure). [Specification, at page 2, lines 19-22]

The emulsifier system also provides farinaceous food products which exhibit improved dough antisticking properties; these anti-stick properties are important to aid in formulation, processing and manufacturing flexibility, and are particularly important in the manufacture of embossed snacks such as, for example, Pringles Ridges®. Additionally, these anti-stick properties are important in relatively "weak" doughs (e.g., reduced sheet strength) such as doughs used for crackers and tortillas. [Specification, at page 2, lines 23-28]

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

3

The improved emulsifier system of the present invention can be used to reduce the level of emulsifier needed in the dehydration process. In particular, it reduces the level of the emulsifier(s) needed as a processing aid in the drum drying operation. This reduces the cost of raw materials, as well as the potential for formation of off-flavors due to oxidation. In addition, the improved emulsifier system of the present invention may reduce potato cell breakage in the drum drying operation, which results in higher levels of flavor precursors. This results in farinaceous food products of improved flavor. [Specification, at page 2, lines 29-35]

For a fat-free snack such those fried in olestra, the level of emulsifiers in the dehydrated starch ingredients may be decreased. This allows the formulator to increase the level of other sources of triglycerides and still provide the reduced level of fat in the finished product necessary in most territories to make the fat-free claim. [Specification, at page 2, line 36-page 3, line 2]

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Are Claims 1-5 and 7-12 obvious over US Patent 4,680,184 to Seiden, under 35 U.S.C. § 103 (a)?

Are Claims 1, 38 and 40 novel over US Patent 6,242,499 B1 to Gruning, under 35 U.S.C. § 102 (e)?

Are Claims 39 and 41 obvious over Gruning, under 35 U.S.C. § 103 (a)?

#### ARGUMENTS

##### A. The Examiner's Rejections

##### Section 103 Rejection Over Seiden:

Claims 1-5 and 7-12 are rejected as being obvious under 35 USC 103(a) over U.S. Patent No. 4,680,184 to Seiden et al. (hereafter "Seiden"). At page 2 of the previous Office Action, the Examiner asserts that Seiden discloses emulsifier compositions that contain (i) 0-60% fatty acid esters of polyols (the Examiner characterizes PGEs as being within this polyol description by Seiden), (ii) fatty acid mono-diglyceride and (iii) fatty acid monoglyceride esters of polycarboxylic acids. (Appellants note that component (iii) monoglyceride esters of polycarboxylic acids, is actually mentioned by Seiden et al. as an optional ingredient.) The Examiner admits that Seiden does not teach claimed amount of polyglycerol ester, but asserts that absent a showing of unexpected results such a limitation would be obvious to a skilled artisan.

With respect to the mono-diglyceride component, Seiden provides that this material is included in an amount of from about 40 to about 100% by weight. (See Summary of the Invention at Col. 2.) At Col. 4, lines 21-25, Seiden provides that it is preferred that the described

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

4

emulsifier compositions comprise from about 50 to 100%, more preferably from about 70 to 100%, mono-diglyceride.

In contrast, Appellants' amended Claim 1 provides that the emulsifier system comprises 70-100% of the polyglycerol ester (PGE) material(s). Clearly, if any mono-diglyceride were included in Appellants' emulsifier system, it would only be at a level up to 30%, which is well below the teaching of Seiden. Appellants respectfully submit that Seiden does not describe Appellants' high PGE-content emulsifier systems. Moreover, Seiden does not suggest that such systems would provide beneficial properties, particularly when one considers that Seiden prefers much higher mono-diglyceride content and, therefore, much lower polyglycerol ester content.

The Examiner bears the burden of factually supporting any *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983). If the Examiner does not prove a *prima facie* case of unpatentability, then without more, the Appellant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must meet three basic criteria. First there must be a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. And finally, the prior art reference (or references when combined) must teach all of the claim limitations. See, for example, In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991). Appellants respectfully assert that the references cited in the Office Action fail to teach all claim limitations, and thus, fail to establish a *prima facie* case of obviousness under 35 U.S.C. §103.

In the present case, the Examiner has compared the reference to the present claims, noted the differences and made the unsupported conclusion that the modifications to Seiden necessary to arrive at the present invention are obvious absent the showing of unexpected results. The Examiner has not met the burden in this case. There is no teaching or suggestion in Seiden itself that the modifications should be made, nor is there any teaching or suggestion of the benefits that would ensue should the modifications be made. Nor does the Examiner assert that these teachings exist. As such, the Examiner has failed to establish a *prima facie* of obviousness. Having failed to meet the burden of first establishing a *prima facie* case of obviousness, unexpected results need not be show.

But even if unexpected results need not be shown, the Appellants have demonstrated numerous benefits of the present emulsifier systems, including an increase in the production rate of fabricated snack chips (e.g. potato chips, tortilla chips, corn chips and the like), a decrease in

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

5

production costs, or both. Additionally, product aging (i.e., staling) can be improved, along with increased flexibility in the process of formulating snacks using rice, wheat, corn and potato ingredients. Process control optimization can be achieved with the present emulsifier system that allows the maximization of line speed control. Moreover, improved dough antisticking properties can be achieved with the present emulsifier systems. These anti-stick properties are important to aid in formulation, processing and manufacturing flexibility, and are particularly important in the manufacture of embossed snacks such as, for example, Pringles Ridges®.

Finally, among the more important benefits of this invention is the ability to reduce the level of emulsifier needed in the dehydration process. This in turn reduces the cost of raw materials, as well as the potential for formation of off-flavors due to oxidation, which improves the flavor of the resulting chip. Decreasing the level of emulsifiers in the dehydrated starch ingredients allows the formulator to increase the level of other sources of triglycerides and still provide the reduced level of fat in the finished product. This is especially important when trying to reduce the fat content enough to make a "fat free" claim.

It is respectfully requested that the present rejection of claims 1-5 and 7-12 as being obvious under 35 USC 103(a) over Seiden be overturned because the Examiner has failed to establish a *prima facie* case of obviousness.

Section 102 and 103 Rejections Over Gruning:

***Section 102 Over Gruning***

Claims 1, 38 and 40 are rejected as being anticipated under 35 USC 102(e) by U.S. Patent No. 6,242,499 to Gruning et al. (hereafter "Gruning"). Claims 39 and 41 are rejected as being obvious under 35 USC 103(a) over Gruning.

The Examiner asserts that Gruning describes polyglycerol ester emulsifiers that read on Appellants' claims. The Examiner specifically asserts that Gruning teaches esters obtained by esterification of a polyglycerol mixture with fatty acids having from 12-22 carbons, and that the degree of esterification is between 30 and 75%. The Examiner further asserts that Gruning teaches polyglycerol esters where the backbone of the polyglycerol has oligomer distribution overlapping with that claimed by Appellants.

The crux of the Gruning reference is the use of polyfunctional carboxylic acids to form polyglycerol esters that are improved water-in-oil ("W/O") emulsifiers. At the paragraph spanning Columns 1 and 2, Gruning et al. state that

[i]t was an object of the invention to provide novel polyglycerol esters which can be prepared from nature materials and, compared with polyglycerol

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

6

polyhydroxystearate exhibit the additional advantage of improved stability, in particular higher freeze-thaw stability, of the W/O emulsions prepared therewith.

Extended storage at very low temperatures or extreme temperature changes during relatively long transport distances can cause the inadequate emulsion stability to become apparent..., or even can result in complete emulsion break-down, which is avoided by the novel solution to the-object [sic].

In the Field of the Invention section, Gruning indicates that the emulsifiers described are useful in the cosmetic, pharmaceutical and micropigments fields.

Under 35 U.S.C. § 102, a claim is anticipated only if each and every claim limitation is found, either expressly or inherently disclosed, in a single prior art reference. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there. See *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Additionally, there must be no difference between what is claimed and what is disclosed in the applied reference. See *Scripps v. Genetech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

In contrast to the disclosure of Gruning, Appellants describe fatty acid(s) for use in forming the claimed PGEs. Specifically, Claim 1 now provides that the fatty acids are selected from oleic acid, palmitic acid, stearic acid, intermediate melting fatty acids, and mixtures thereof. Thus, claim 1 does not encompass the polyfunctional carboxylic acid containing polyglycerols described by Gruning, and is novel over Gruning. Claims 38 and 40 depend directly from claim 1 and are both novel over Gruning.

Accordingly, it is respectfully requested that the present rejection of claims 1, 38 and 40 as lacking novelty under 35 USC 102(e) over Gruning be overturned because Gruning fails to disclose the claimed fatty acids used to produce the present emulsifier systems.

#### ***Section 103 Over Gruning***

With regard to claims 39 and 41, which depend indirectly from claim 1, the Examiner has failed to meet the burden of establishing a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must first establish that there is a suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. In the previous Office Action, at page 3, the Examiner appears to agree that the poly functional carboxylic acids are different than the fatty acids of claim 1 and 38-41 (this alone seems to negate the novelty rejection discussed above). The Examiner then suggests that because the poly functional carboxylic acids of Gruning are not



Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

7

expressly excluded from the claims, that Gruning renders these claims obvious. This assertion does not meet the Examiner's legal standard. There is no teaching or suggestion in Gruning or in the possession of the skilled artisan that this modification should be made. Once again, the Examiner relies on unsupported conclusion that because Gruning relates to an emulsifier (for an entirely different field of use) that all of the modifications necessary to get from Gruning's teachings to the present claims are obvious. This does not meet the Examiner's legal standard.

Therefore, it is respectfully requested that the present rejection of claims 39 and 41 as being obvious under 35 USC 103(a) over Gruning be overturned because the Examiner has failed to establish a *prima facie* case of obviousness.

## CONCLUSION

For all of the foregoing reasons, it is respectfully asserted that the emulsifier systems of the present claims are indeed patentable over the prior art. Reversal of these rejections is therefore respectfully requested.

1  
 2  
 3  
 4  
 5  
 6  
 7  
 8  
 9  
 10  
 11  
 12  
 13  
 14  
 15  
 16  
 17  
 18  
 19  
 20  
 21  
 22  
 23  
 24  
 25  
 26  
 27  
 28  
 29  
 30  
 31  
 32  
 33  
 34  
 35  
 36  
 37  
 38  
 39  
 40  
 41  
 42  
 43  
 44  
 45  
 46  
 47  
 48  
 49  
 50  
 51  
 52  
 53  
 54  
 55  
 56  
 57  
 58  
 59  
 60  
 61  
 62  
 63  
 64  
 65  
 66  
 67  
 68  
 69  
 70  
 71  
 72  
 73  
 74  
 75  
 76  
 77  
 78  
 79  
 80  
 81  
 82  
 83  
 84  
 85  
 86  
 87  
 88  
 89  
 90  
 91  
 92  
 93  
 94  
 95  
 96  
 97  
 98  
 99  
 100  
 101  
 102  
 103  
 104  
 105  
 106  
 107  
 108  
 109  
 110  
 111  
 112  
 113  
 114  
 115  
 116  
 117  
 118  
 119  
 120  
 121  
 122  
 123  
 124  
 125  
 126  
 127  
 128  
 129  
 130  
 131  
 132  
 133  
 134  
 135  
 136  
 137  
 138  
 139  
 140  
 141  
 142  
 143  
 144  
 145  
 146  
 147  
 148  
 149  
 150  
 151  
 152  
 153  
 154  
 155  
 156  
 157  
 158  
 159  
 160  
 161  
 162  
 163  
 164  
 165  
 166  
 167  
 168  
 169  
 170  
 171  
 172  
 173  
 174  
 175  
 176  
 177  
 178  
 179  
 180  
 181  
 182  
 183  
 184  
 185  
 186  
 187  
 188  
 189  
 190  
 191  
 192  
 193  
 194  
 195  
 196  
 197  
 198  
 199  
 200  
 201  
 202  
 203  
 204  
 205  
 206  
 207  
 208  
 209  
 210  
 211  
 212  
 213  
 214  
 215  
 216  
 217  
 218  
 219  
 220  
 221  
 222  
 223  
 224  
 225  
 226  
 227  
 228  
 229  
 230  
 231  
 232  
 233  
 234  
 235  
 236  
 237  
 238  
 239  
 240  
 241  
 242  
 243  
 244  
 245  
 246  
 247  
 248  
 249  
 250  
 251  
 252  
 253  
 254  
 255  
 256  
 257  
 258  
 259  
 260  
 261  
 262  
 263  
 264  
 265  
 266  
 267  
 268  
 269  
 270  
 271  
 272  
 273  
 274  
 275  
 276  
 277  
 278  
 279  
 280  
 281  
 282  
 283  
 284  
 285  
 286  
 287  
 288  
 289  
 290  
 291  
 292  
 293  
 294  
 295  
 296  
 297  
 298  
 299  
 300  
 301  
 302  
 303  
 304  
 305  
 306  
 307  
 308  
 309  
 310  
 311  
 312  
 313  
 314  
 315  
 316  
 317  
 318  
 319  
 320  
 321  
 322  
 323  
 324  
 325  
 326  
 327  
 328  
 329  
 330  
 331  
 332  
 333  
 334  
 335  
 336  
 337  
 338  
 339  
 340  
 341  
 342  
 343  
 344  
 345  
 346  
 347  
 348  
 349  
 350  
 351  
 352  
 353  
 354  
 355  
 356  
 357  
 358  
 359  
 360  
 361  
 362  
 363  
 364  
 365  
 366  
 367  
 368  
 369  
 370  
 371  
 372  
 373  
 374  
 375  
 376  
 377  
 378  
 379  
 380  
 381  
 382  
 383  
 384  
 385  
 386  
 387  
 388  
 389  
 390  
 391  
 392  
 393  
 394  
 395  
 396  
 397  
 398  
 399  
 400  
 401  
 402  
 403  
 404  
 405  
 406  
 407  
 408  
 409  
 410  
 411  
 412  
 413  
 414  
 415  
 416  
 417  
 418  
 419  
 420  
 421  
 422  
 423  
 424  
 425  
 426  
 427  
 428  
 429  
 430  
 431  
 432  
 433  
 434  
 435  
 436  
 437  
 438  
 439  
 440  
 441  
 442  
 443  
 444  
 445  
 446  
 447  
 448  
 449  
 450  
 451  
 452  
 453  
 454  
 455  
 456  
 457  
 458  
 459  
 460  
 461  
 462  
 463  
 464  
 465  
 466  
 467  
 468  
 469  
 470  
 471  
 472  
 473  
 474  
 475  
 476  
 477  
 478  
 479  
 480  
 481  
 482  
 483  
 484  
 485  
 486  
 487  
 488  
 489  
 490  
 491  
 492  
 493  
 494  
 495  
 496  
 497  
 498  
 499  
 500  
 501  
 502  
 503  
 504  
 505  
 506  
 507  
 508  
 509  
 510  
 511  
 512  
 513  
 514  
 515  
 516  
 517  
 518  
 519  
 520  
 521  
 522  
 523  
 524  
 525

Respectfully submitted,  
For: LIN, ET AL.

By S. Robert Chuey  
Attorney for Appellants  
Registration No. 39,140  
Telephone: (513) 634-0102

Date: May 8, 2006  
Customer No. 27752

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

8

## CLAIMS APPENDIX

1. An emulsifier system comprising from 70 to 100%, by weight, of a polyglycerol ester having a polyglycerol backbone of from 2 to about 10 glycerol units wherein not more than about 40% of the hydroxyl groups of the polyglycerol are esterified with fatty acids (hereafter "PGE") and wherein the fatty acids are selected from the group consisting of oleic acid, palmitic acid, stearic acid, intermediate melting fatty acids, and mixtures thereof.
2. An emulsifier system of Claim 1 wherein at least about 80% of the PGEs, by weight, have a polyglycerol backbone of from 2 to about 5 glycerol units.
3. An emulsifier system of Claim 1 wherein at least about 80% of the PGEs, by weight, have a polyglycerol backbone of 2 or 3 glycerol units.
4. An emulsifier system of Claim 1 wherein from about 20% to about 35% of the hydroxyl groups of the polyglycerol are esterified with fatty acids.
5. An emulsifier system of Claim 1 comprising PGEs wherein at least about 80% of the ester groups are derived from saturated fatty acids.
7. An emulsifier system of Claim 1 wherein the emulsifier system contains not more than about 15% free polyglycerol.
8. An emulsifier system of Claim 1 comprising a material selected from the group consisting of 2-1-P, 2-1-S, 3-1-P, 3-1-S, 4-1-P, 4-1-S, and mixtures thereof.
9. An emulsifier system of Claim 1 further comprising monoglyceride.
10. An emulsifier system of Claim 1 further comprising a lecithin.
11. An emulsifier system of Claim 10 comprising from about 1% to about 25% lecithin, and from about 75% to about 99% PGE.
12. An emulsifier system of Claim 10 further comprising monoglyceride.
38. An emulsifier system of Claim 1 comprising polyglycerol monoesters having a polyglycerol backbone of from 2 to about 10 glycerol units, wherein at least about 40%, by weight, of the polyglycerol monoesters are diglycerol monoesters.

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

9

39. An emulsifier system of Claim 38 wherein at least about 75%, by weight, of the polyglycerol monoesters are comprised of one or more of 2-1-S, 2-1-P and 2-1-IM.

40. An emulsifier system of Claim 1 comprising polyglycerol monoesters having a polyglycerol backbone of from 2 to about 10 glycerol units, wherein at least about 40%, by weight, of the polyglycerol monoesters are di-triglycerol monoesters.

41. An emulsifier system of Claim 40, wherein at least about 75%, by weight, of the polyglycerol monoesters are di-triglycerol monoesters.

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

10

## EVIDENCE APPENDIX

Application Number 09/965,113  
Attorney Docket Number 8258X  
Appeal Brief dated May 8, 2006

11

# RELATED PROCEEDINGS APPENDIX